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IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

HYNIX SEMICONDUCTOR INC., HYNIX  
SEMICONDUCTOR AMERICA INC.,  
HYNIX SEMICONDUCTOR U.K. LTD., and  
HYNIX SEMICONDUCTOR  
DEUTSCHLAND GmbH,

Plaintiffs,

v.

RAMBUS INC.

Defendant.

No. C-00-20905 RMW

ORDER ON PATENT TRIAL MOTION *IN*  
*LIMINE* CONCERNING WRITTEN  
DESCRIPTION EVIDENCE

An issue was raised at the pretrial conference on March 9, 2006 as to whether Hynix can offer evidence of the length of time and number of claim amendments that Rambus made before Rambus made the amendments that allegedly cover Hynix's accused products. As the court ruled in its Motion *In Limine* Order dated March 1, 2006 (MIL Order): "'Whether the written description requirement . . . has been satisfied is based on an *objective* analysis of what the patent has disclosed.' *Metabolite Laboratories, Inc. v. Laboratory Corp. of America Holdings*, 370 F.3d 1354, 1366 (Fed. Cir. 2004). Regardless of how Rambus conceived of its later-filed claims, the specification either supports them or does not. " MIL Order at 15:15-18 (emphasis added). Therefore, substantive evidence offered by Hynix as to how many amendments Rambus made before the subject

1 amendments and whether Rambus got its idea for the subject amendments from a competitor's  
2 product, JEDEC, or some other source is irrelevant (and even if marginally relevant, its relevance is  
3 substantially outweighed by F.R.E. 403 concerns). However, this does not mean if a person of  
4 ordinary skill in the art who is associated with Rambus opines that the specification supports the  
5 subject amendments, he cannot be cross-examined on matters relevant to his credibility. For  
6 example, if one of the inventors, as one skilled in the art, renders the opinion that the specification  
7 supports the subject claims, his credibility has been placed in issue. Therefore, he can be asked  
8 questions that go to his credibility such as: When did you first consider making the subject  
9 amendments? Isn't it true that you made "x" number of amendments over "y" number of years  
10 before you sought to make the subject amendments? Isn't the real reason you made the amendments  
11 that you wanted to cover products that were not disclosed in the patent application? Such questions  
12 would legitimately question the credibility of the opinion that the patent discloses support for the  
13 subject amended claims, i.e. whether the witness really believes that the specification discloses the  
14 invention described in the amended claims.

15         Rambus concedes that such cross-examination might have some relevance but submits that  
16 its relevance to credibility is far outweighed by F.R.E. 403 considerations. Rambus is particularly  
17 concerned that such questions could require the witness to reveal privileged communications. If, for  
18 example, the answer to the question "if you thought the specification supported the new claims, why  
19 was the amendment not sought for ten years?," was advice of counsel, Rambus would be compelled  
20 to reveal privileged information. The court is not convinced that such a question would necessarily  
21 raise privilege concerns, particularly since the witness could probably give his reasons without  
22 revealing communication with counsel. Further, if the witness were asked a proper question and the  
23 answer was advice of counsel, it could be appropriate, depending on the circumstances, for the  
24 witness to just say "advice of counsel" and for the court to instruct Hynix not to ask about the advice  
25 given and to instruct the jury that no adverse inference may be drawn by the witness's failure to  
26 reveal the advice.

27         In summary, the court believes that whether the written description requirement has been met  
28 must be determined by an entirely objective test: "[t]he written description requirement is satisfied if

1 a person of ordinary skill in the field reading the patent application as originally filed would  
2 recognize that the patent application described the invention as finally claimed in the patent."  
3 MODEL PATENT JURY INSTRUCTION FOR THE NORTHERN DISTRICT, 4.2a. Therefore, evidence of the  
4 reason for the amendment and timing of the amendment is irrelevant as substantive or circumstantial  
5 evidence of whether the specification supports the amended claims. However, if one skilled in the  
6 art who was associated with Rambus during the relevant time period, opines that the written  
7 description requirement is satisfied, he is subject to cross-examination about factors that may  
8 question the credibility of his opinion or have colored his testimony. The opinion of an inventor is  
9 likely to carry significant weight and Hynix should not be limited in challenging the credibility of  
10 that opinion.

11  
12 DATED: 3/10/06

/s/ Ronald M. Whyte  
RONALD M. WHYTE  
United States District Judge

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